

REMARKS

This Application has been carefully reviewed in light of the Final Office Action dated November 19, 2008 (the "*Final Office Action*"). At the time of the *Final Office Action*, Claims 1-46 are pending in the Application and Claims 10-34 are withdrawn. The Examiner rejects Claims 1-9 and 35-46. Applicant amends Claim 41 to return it to dependent form. Applicant respectfully requests reconsideration and full allowance of all pending claims.

Section 103 Rejections

The Examiner rejects Claims 1-2, 4-6, 9, 35-41, and 44-46 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,980,862 issued to Arganbright et al. ("*Arganbright*") in view of U.S. Patent No. 6,246,997 issued to Cybul et al. ("*Cybul*"). The Examiner rejects Claims 3, 7-8, and 42-43 under 35 U.S.C. § 103(a) as being unpatentable over *Arganbright* in view of *Cybul* in further view of U.S. Patent Application Publication No. 2002/0010634 issued to Roman et al. ("*Roman*") and official notice.

A. Claims 1-2, 4-6, 9, 35-41, and 44-46 are Allowable over the Proposed *Arganbright-Cybul* Combination

Applicant appreciates the Examiner's thoughtful consideration of this case. Because Applicant believes that the claims are in condition for allowance, however, Applicant has not amended the claims. Applicant respectfully requests reconsideration of the rejection of Claims 1-2, 4-6, 9, 35-41, and 44-46 for the reasons discussed below.

1. The proposed combination does not disclose, teach, or suggest "*in response to and after displaying the transaction history, receiving an electronic selection, generated by the consumer on the computerized system associated with the consumer, of a particular item of merchandise within the listing of merchandise in the displayed transaction history, the electronic selection comprising a click on the particular item of merchandise within the list of merchandise and identifying the particular item of merchandise for returns processing.*"

As a first example of the deficiencies of the *Arganbright-Cybul* combination, Applicant respectfully submits that the cited references do not disclose, teach, or suggest “in response to and after displaying the transaction history, receiving an electronic selection, generated by the consumer on the computerized system associated with the consumer, of a particular item of merchandise within the listing of merchandise in the displayed transaction history, the electronic selection comprising a click on the particular item of merchandise within the list of merchandise and identifying the particular item of merchandise for returns processing,” as recited in Claim 1.

In the *Final Office Action*, the Examiner acknowledges that *Arganbright* does not disclose the recited claim elements and instead relies upon *Cybul*. (*Final Office Action*, page 3). Applicant respectfully disagrees.

The cited portion of *Cybul* merely discloses “a list builder tool” that “efficiently find[s] and select[s] the past shopping history of respective shoppers and import[s] that data to the list builder’s on-line historical purchase list database, thereby making it available for the shoppers’ first and subsequent on-line shopping experiences.” (*Cybul*, Column 4, lines 25-35). Thus, the selection referred to by *Cybul* is performed by a server-based “list builder tool.” The application finds and selects items previously purchased by the customer. The selection, however, is not by a customer, via a web access tool. The selection is not a click on the particular item of merchandise, and the selection does not identify a particular item of merchandise for returns processing. Accordingly, it is Applicant’s position that neither *Arganbright* nor *Cybul* (or their proposed combination) disclose, teach, or suggest “in response to and after displaying the transaction history, receiving **an electronic selection, generated by the consumer** on the computerized system associated with the consumer, of **a particular item of merchandise** within the listing of merchandise in the displayed transaction history, the electronic selection comprising a click on the particular item of merchandise within the list of merchandise and **identifying the particular item of merchandise for returns processing**,” as recited in Claim 1. The recited claim elements are absent from the disclosures of *Arganbright* and *Cybul*.

Additionally, Applicant submits that it would not have been obvious to one of ordinary skill in the art at the time the invention was made to modify *Arganbright* in view of *Cybul* to include an electronic selection from a displayed list of items to the consumer to identify an item for returns processing.

Arganbright discloses that the process for handling returns begins when “the system presents the user with a copy of the satisfaction guarantee 2702.” (Column 63, lines 3-5). Thus, the process initiates with the presentation of the return policy to the user. “After the user has a chance to review satisfaction guarantee 2702, the user selects whether the user wishes to “return” or “exchange” (box 2704) an item or plurality of items.” (Column 63, lines 8-11). Thus, the first electronic request received from the user relating to the return of a product is the selection of either a “return” button or an “exchange” button. “If the user selects “return,” an online return form 2706 is presented to the user.” (Column 63, lines 12-13). “The user is then requested to enter a plurality of information (box 2708) on return form 2706, including but not limited to, quantity, stock number or SKU, the reason for the return, product description, and an invoice number.” (Column 63, lines 13-17, emphasis added). Once the return form is populated by the customer’s input, the return form is “presented to the user in a format (box 2710) that can be printed on a conventional printer connected to the user’s computer” and that the user “is requested to print the form and include the form in the box containing the product or products to be returned.” (Column 63, lines 23-29). Thus, the form must be filled out by the customer and the transaction information is provided in the box of merchandise returned by the customer. Nothing is presented to the user that would be appropriate for selection by a click on a particular item of merchandise to identify that item for returns processing.

Even when considered in conjunction with the disclosure of *Cybul*, Applicant’s claim language would not have been obvious to one of ordinary skill in the art. As discussed above, *Cybul* relates to a system for online shopping that “takes advantage of the data already being gathered by POS systems on consumer shopping habits and preferences.” (*Cybul*, Column 1, lines 36-38). Specifically, *Cybul* discloses that where a vendor’s POS system “supports a frequent shopper or loyalty program . . . [or] a database

of historical purchase data indexed by loyalty customer,” the information may be extracted from the vendor’s POS system. (*Cybul*, Column 4, lines 25-34; Column 1, lines 63-65). As a result, a list builder tool can “efficiently find and select the past shopping history of respective shoppers and import that data to the list builder’s on-line historical purchase list database, thereby making it available for the shoppers’ first and subsequent on-line shopping experiences.” (*Cybul*, Column 4, lines 29-34). As such, *Cybul* merely discloses that a shopper’s purchases in a brick-and-mortar store are used to develop an online shopping list for that shopper’s subsequent purchases on-line.

Accordingly, at most the *Arganbright-Cybul* combination discloses that during an online purchase, a customer’s in store purchases may be used to efficiently develop an on-line shopping list. If an item were needed to be returned after the purchase is complete, the proposed combination merely discloses that a return form could be obtained on-line and filled out by the customer on the customer’s computer, as disclosed in *Arganbright*. The form would then be printed and placed in the box for shipping. It would not have been obvious to one of ordinary skill in the art to modify the return process of *Arganbright* and the purchase process of *Cybul* to result in Applicant’s recited step of “in response to and after displaying the transaction history, receiving an electronic selection, generated by the consumer on the computerized system associated with the consumer, of a particular item of merchandise within the listing of merchandise in the displayed transaction history, the electronic selection comprising a click on the particular item of merchandise within the list of merchandise and identifying the particular item of merchandise for returns processing,” as recited in Claim 1.

For at least these additional reasons, Applicant respectfully requests reconsideration and allowance of independent Claim 1, together with Claims 2, 4-6, 9, 35-41, and 44-45 that depend on Claim 1. For analogous reasons, Applicant also requests reconsideration and allowance of independent Claim 46.

2. The proposed combination does not disclose, teach, or suggest “*in response to receiving the electronic selection comprising the click on the particular item of merchandise within the list of merchandise, initiating a returns process for the particular item of merchandise selected by the consumer from the list of merchandise purchased by*

the consumer in the prior purchase transaction, the returns process initiated by a returns server.”

As a second example of the deficiencies of the *Arganbright-Cybul* combination, Applicant respectfully submits that the cited references do not disclose, teach, or suggest “in response to receiving the electronic selection comprising the click on the particular item of merchandise within the list of merchandise, initiating a returns process for the particular item of merchandise selected by the consumer from the list of merchandise purchased by the consumer in the prior purchase transaction, the returns process initiated by a returns server,” as recited in Claim 1.

In the *Final Office Action*, the Examiner relies upon *Arganbright* for the operation of initiating a returns process by a returns server in response to a selection of an item. (*Final Office Action*, page 2). Initially, Applicant respectfully notes that Applicant’s claim does not merely recite receiving from the consumer an electronic request to initiate return processing. Applicant’s claim recites “initiating a returns process for the particular item of merchandise . . . by a returns server,” and this operation is not disclosed in *Arganbright*.

Arganbright merely discloses that “[a]fter the user has a chance to review satisfaction guarantee 2702, the user selects whether the user wishes to “return” or “exchange” (box 2704) an item or plurality of items.” (Column 63, lines 8-11). Thus, this portion refers to the selection of either a “return” button or an “exchange” button by a user. Applicants point out that the selection of the “return” button occurs before the user populates the form and before the user identifies a product by sku # for return. (Column 63, lines 12-22). As a result, the selection of the “return” button occurs before an item of merchandise is identified for return. The mere presentation of form before the identification of the product to be returned is not analogous to “initiating a returns process for the particular item of merchandise selected by the consumer from the list of merchandise purchased by the consumer in the prior purchase transaction, the returns process initiated by a returns server,” as recited by Applicant’s amended Claim 1. Further, because there is no disclosure in *Arganbright* of any returns processing being initiated after the form is populated, the system of *Arganbright* cannot be said to perform any returns processing.

Applicant additionally notes that in the *Final Office Action* the Examiner relies upon *Cybul* for disclosure of the electronic selection of the particular item of merchandise and upon *Arganbright* for the operation of initiating a returns process by a returns server. (*Final Office Action*, pages 3-5). However, Applicant's claim recites a specific order to and interrelation between the steps of the claimed method. Specifically, Claim 1 recites "in response to receiving the electronic selection comprising the click on the particular item of merchandise within the list of merchandise, initiating a returns process for the particular item of merchandise selected by the consumer from the list of merchandise purchased by the consumer in the prior purchase transaction, the returns process initiated by a returns server." Thus, a click on a particular item of merchandise previously purchased by a customer is first received from a customer. Then, in response to that click, a returns process for the selected item of merchandise is initiated by a returns server.

To the extent that *Arganbright* discloses initiating a returns process by a returns server (which Applicant expressly disputes above), such returns process is not "in response to receiving the electronic selection comprising the click on the particular item of merchandise within the list of merchandise" from the customer. Applicant also notes that *Cybul* does not at all relate to a returns process or to the processing of returns of merchandise. Even more troubling, as shown above in Section A(1) of this Response, *Cybul* does not even disclose the recited "electronic selection comprising the click on the particular item of merchandise" from the customer. The M.P.E.P. provides that "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03 (citing *In re Wilson*, 424 F.2d 1382, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)). Because of the deficiencies of these references and the deficiencies of their proposed combination, Applicants respectfully submit that the piecemeal rejection of Applicant's claim over the proposed *Arganbright-Cybul* combination fails to give credence to the particular combination of claim elements and the sequence of claim steps specifically recited in Applicant's claim.

For at least these additional reasons, Applicant respectfully requests reconsideration and allowance of independent Claim 1, together with Claims 2, 4-6, 9, 35-

40, and 44-45 that depend on Claim 1. For analogous reasons, Applicant also requests reconsideration and allowance of independent Claim 46.

B. Claim 41 are Allowable over the Proposed *Arganbright-Cybul* Combination

Claim 41 depends upon independent Claim 1, which Applicant has shown above to be allowable. Accordingly, dependent Claim 41 are not obvious over the various combinations of references relied upon by the Examiner at least because Claim 41 include the limitations of Claim 1. Additionally, dependent Claim 41 recite further elements that distinguish Applicant's claims over the prior art of record.

For example, Claim 41 recites "identifying the consumer, wherein identifying the consumer comprises receiving a client system identifier in a message from the consumer." In the *Final Office Action*, the Examiner relies upon *Arganbright* for disclosure of the recited claim elements. (*Final Office Action*, page 41). However, the cited portion of *Arganbright* merely discloses that "WWW shoppers are also preferably able to search and add to their shopping cart specific product SKUs, or identification numbers." (*Arganbright*, Column 48, lines 5-14). Using conventional online shopping techniques, users can add selected products to a shopping basket. (*Arganbright*, Column 48, lines 33-38). During checkout, the user is authenticated upon being "forwarded to a login/create new user page (not shown)." (*Arganbright*, Column 48, lines 52-62). Thus, the cited portion of *Arganbright* merely discloses allowing a user to purchase items placed in an online shopping basket after user authentication. There is no disclosure of "a client system identifier." To the contrary, login information is associated with the user not the client system that the user uses. Accordingly, the proposed *Arganbright-Cybul* combination does not disclose, teach, or suggest "identifying the consumer, wherein identifying the consumer comprises receiving a client system identifier in a message from the consumer," as recited in Claim 41.

C. Claims 3, 7-8, and 42-43 are Allowable over the Proposed *Arganbright-Cybul-Roman-Official Notice* Combination

Claims 3, 7-8, and 42-43 depend upon independent Claim 1, which Applicant has shown above to be allowable. Accordingly, dependent Claims 3, 7-8, and 42-43 are not obvious over the various combinations of references relied upon by the Examiner at least because Claims 3, 7-8, and 42-43 include the limitations of Claim 1. Additionally, dependent Claims 3, 7-8, and 42-43 recite further elements that distinguish Applicant's claims over the prior art of record. Since Applicant has shown independent Claim 1 to be allowable, however, Applicant has not provided detailed arguments with respect to Claims 3, 7-8, and 42-43. Applicant remains ready to do so if it becomes appropriate.

Additionally, Applicant notes the Examiner's indication that the Examiner takes Official Notice of one or more claim elements. (*Final Office Action*, page 6). However, with regard to Claims 3, 7-8, and 42-43, Applicant finds no specific claim elements of which the Examiner takes Official Notice. Regardless, Applicant traverses any taking of Official Notice. To the extent that the Examiner maintains a rejection based on "Official Notice," "well-known art," common knowledge, or other information within the Examiner's personal knowledge, Applicant respectfully requests that the Examiner cite a reference in support of this position or provide an affidavit in accordance with M.P.E.P. § 2144.03 and 37 C.F.R. § 1.107.

No Waiver

Additionally, Applicant has merely discussed example distinctions from the references cited by the Examiner. Other distinctions may exist, and Applicant reserves the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicant does not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicant are sufficient to overcome the Examiner's rejections.

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20

CONCLUSION

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of all pending claims.

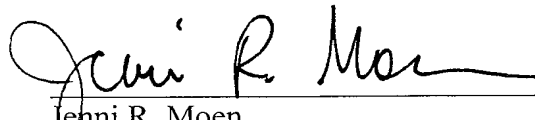
If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Jenni R. Moen, Attorney for Applicant, at the Examiner's convenience at (214) 415-4820.

Applicant believes that no fees are due; however, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.

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